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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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RANDAL D. HOMBURG
Attorney at Law
P.O. Box 10470
MIDWEST CITY, OK 73140-1470

EXAMINER

WAKS, JOSEPH

ART UNIT

PAPER NUMBER

2834

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/931,042

Examiner

Joseph Waks

Applicant(s)

SLATKIN, JEFFREY H.

Art Unit

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

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In line 1, "The invention is" is a phrase that can be implied.

Claim Objections

3. **Claims 1, 2 and 5** are objected to because of the following informalities: they do not comply with MPEP § 608.01(m) that requires each claim to begin with a capital letter and to end with a period. Periods may not be used elsewhere in the claims except for abbreviations. *See Fressola v. Manbeck*, 36 USPQ2d1211 (D.D.C. 1995). Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 2-5** are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The material that will not permanently deform when subjected to repeated exposure to heavy traffic conditions over time or will not deform over time by the constant flow of traffic is not disclosed in the specification. Moreover, the known construction materials will deform over time when exposed to traffic load over sufficiently long period of time.

6. **Claims 2-5** are also rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For the reasons indicated above one skilled in the art would not be able to make and/or use the invention.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 1-5** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 2, “, such compression” and “such usable electrical current” render the claim indefinite because it is unclear whether the limitation following the phrase “such” are part of the claimed invention or not, and the resulting claim does not clearly set forth the metes and bounds of the patent protection desired, examiner suggests to delete the first phrase and to replace “such” with –said– in the second phrase.

In claim 2, line 9, “before “electro-mechanical” delete “an”, lines 10, before “means” and line 16 before “base” replace “such” with –said--.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claim 1** is rejected under 35 U.S.C. 102(b) as being anticipated by **McGee (US 4,614,875)**.

McGee discloses in Figures 1, 2, and 4 invention as claimed: a device embedded within a roadway 290 having: a deformable upper plate 239, a plurality of electromechanical generating pumps 101-119, a rigid lower plate (the bottom of casing 201), wherein passing vehicles compress the deformable plate that in turn compresses the pumps between the deformable plate and the rigid plate producing a usable electrical current.

The electrical conductor wires transferring the current from the pumps to the point of use are inherent to the disclosed structure and are addressed in column 4, lines 59-61.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 2-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over **McGee (US 4,614,875)** in view of **Schenavar (US 4,032,829)**.

McGee discloses in Figures 1, 2, and 4 invention as claimed: a device embedded within a roadway 290 having: a deformable upper plate 239, a series of individual rigid tread plates 231a and 235a linked together by lining plates 207 and linking pins 231b and 235b, a rigid lower plate (the bottom of casing 201), a plurality of electromechanical generating pumps 101-119 each having an upper piston cap 240, a driver arm 252 descending from the lower surface of the upper piston cap, a base piston shell 201 a spring 258 compressibly connecting the upper piston cap and base piston shell, a generator 210 affixed to the upper surface of the base member having a drive gear 278 engaging the driver arm. However, **McGee** does not disclose the upper piston cap having a cavity and top end piece and a base piston shell having an interior cavity.

Schenavar discloses an energy converter system utilizing the upper piston cap 48 having a cavity and top end piece 52 with a driver 56 extending from the lower surface of the end piece and a base piston shell 44 having an interior cavity and a base compressibly connected to the upper piston cap by the spring 66 for the purpose of directly transferring the linear movement of the driver to the rotary movement of the pinion 74 driving a generator 90.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design the device as taught by **McGee** and to provide the upper piston cap having a cavity and top end piece and a base piston shell having an interior cavity as taught by **Schenavar** for the purpose of simplifying the transmission of linear movement of the flexible plate by directly transferring the linear movement to the rotary movement driving the generator.

It would have been further obvious to one having ordinary skill in the art at the time the invention was made to design the device as taught by **McGee** and to provide the three phase Y wired generator for the purpose of connecting the generator to a three phase distribution system since the examiner takes Official Notice the three phase Y connected generators are well known in the art for their use in the three phase electrical distribution systems and the selection of such generator to supply such system would be well within the level of ordinary skill in the art.

Re claim 5, the combined device discloses the structure as claimed. Claim 5 that merely recites connecting and using the disclosed features together is inherent to the disclosed structure.

Prior Art

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Communication

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Waks whose telephone number is (703) 308-1676. The examiner can normally be reached on Monday through Thursday 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor R Ramirez can be reached on (703) 308-1371. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 305-1341 for regular communications and (703) 305-1341 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.


JOSEPH WAKS
PRIMARY PATENT EXAMINER
TC-2800

JW
November 17, 2002